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| 09/477,413      | 01/04/2000  | ZACHARY DAVID DIMENSTEIN | P55941              | 9205             |

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| ART UNIT | PAPER NUMBER |
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2135

DATE MAILED: 04/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/477,413

Applicant(s)

DIMENSTEIN, ZACHARY DAVID

Examiner

Paula W Klimach

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to amendment filed on 12/29/03 (Paper No. 6). Original application contained Claims 1. Applicant added Claims 2-23 and cancelled Claims 1. The amendment filed on 12/29/03 have been entered and made of record. Therefore, presently pending claims are 2-23.

### ***Response to Arguments***

2. Applicant's arguments filed 12/29/03 have been fully considered but they are not persuasive because of the new grounds of rejection as presented below.

The examiner asserts that the prior art does teach or suggest the subject matter broadly recited in independent Claims 2 and 12. Dependent Claims 3-11 and 13-23 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action (Paper No. 7). Accordingly, rejections for claims 2-23 are respectfully maintained.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boccon-Gibod et al (2001/0016836 A1) in view of article from North Communications.

Boccon-Gibon discloses a system in which a command is received from the user to download at least one file from a selected online server, web site, (Fig 5 part 510, page 3 paragraph 35 and 36). The files disclosed by Boccon-Gibon are stored in a client database, therefore the user saves the files and play them (Fig 6 part 600 and 610). Boccon-Gibon discloses a system in which the user forwards their information to the selected server (page 3 paragraph 34). The server transmits encryption information, playback encryption key, in response to the request for multimedia (page 4 paragraph 40). Boccon-Gibon discloses the client decrypting the multimedia using the playback key in order to play it (page 5 paragraph 48 and 49). Boccon-Gibon also discloses that re-encrypting the media by a playback module (page 3 paragraph 30), therefore if the information is received in the unencrypted form the playback module is able to encrypt the information. Therefore the information is both stored in encrypted format and is converted to an encrypted format in accordance with the encryption information (playback key).

However Boccon-Gibon does not disclose forwarding a query to at least one server to determine if the retrieved address is within an approved web site database; notifying the user that the selected web site is not within the approved web site database upon a determination that the selected web site is not within the approved web site database; forwarding user information and information with regard to the at least one file to the at least one server upon a determination that the selected web site is within the approved web site database; downloading the at least one file in an unencrypted format from the selected web site

North Communications discloses a system that has a server that contains a list of approved websites; therefore the kiosk, used to browse the Internet, sends the query for the

Art Unit: 2135

website to the server, which determines whether it is within the approved web site database. The user is notified that the selected web site is not within the approved web site by sending the user a 'sorry' message (page 2 paragraph 2). The list of the approved websites can be maintained on a NetGain Server, therefore the client has to forward a query to the server to find if the website is on the list. The user is then allowed to view the website, therefore the users information is forwarded to the server to download the on the approved website. There is not encryption step included in the procedure therefore the file is downloaded in the unencrypted form.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the list of approved websites and download the information in the unencrypted form as disclosed by North communications in the system of Boccon-Gibon. One of ordinary skill in the art would have been motivated to do this because it would discourage users from visiting unsuitable websites (page 2 paragraph 2) and in the case that the playback device does not have enough calculation power to encrypt the information then it would store the downloaded information in the unencrypted form or encrypt it partially.

*In reference to claims 3 and 13*, Boccon-Gibon discloses the choice of encrypted format or unencrypted format, therefore giving the user the choice to store that file in either format (page 4 and 5 paragraph 46).

*In reference to claims 4 and 14*, Boccon-Gibon discloses the user requesting the media to be played, and retrieving the file that can be either stored in the encrypted form or the unencrypted form; determining which key to use for decryption; and finally outputting the media (pages 4 and 5 paragraphs 46-49).

*In reference to claims 5 and 17*, the selected address disclosed by the article by north communications is an Internet address. The kiosk is used for internet access as shown on page 1 paragraph 5.

*In reference to claims 6 and 18* Boccon-Gibon discloses memory for storing the encrypted content (page 3 paragraph 28). However, Boccon-Gibon also discloses the possibility of keeping the media in unencrypted form (page 4 and 5 paragraph 0046).

*In reference to claims 7 and 19*, wherein the at least one decrypted file is transferred to a digital storage device prior to playing or displaying to the user now decrypted at least one file (page 2 paragraph 27).

*In reference to claims 8 and 20*, the approved website list, disclosed by the article of North Communications, is stored on the NetGain server (page 2 paragraph 2).

*In reference to claims 9 and 21*, the file disclosed by Boccon-Gibon is downloaded from an external source in the form of a server (Fig. 1 part 100, in combination with page 2 paragraph 22). Boccon-Gibon discloses a system that is capable of maintaining a file in its encrypted state by decrypting, so as to send it to the portable music player, and then re-encrypting the file, for storage in the portable music player; therefore encrypting file before storing the file (page 3 paragraph 30).

*In reference to claim 10 and 22*, Boccon-Gibon discloses the system receiving a command from the user to play the at least one file stored in the encrypted format; retrieving the at least one file stored in the encrypted format and decrypting the at least one file stored in the encrypted format with a previously stored encryption key in response to the user to play the at

least one file stored in the encrypted format; and play to the user the now decrypted at least one file (Boccon-Gibon pages 4 and 5 paragraphs 46-49).

*In reference to claims 11*, Boccon-Gibon discloses transferring a decrypted file to a digital storage device (page 3 paragraph 29-30). The device is a portable music player, it is therefore suggested that the music will be played.

*In reference to claim 15*, Boccon-Gibon discloses transferring a stored and now decrypted file from the memory to the digital storage device (page 3 paragraph 29-30).

*In reference to claim 16 and 23*, Boccon-Gibon discloses transferring the now decrypted file from the memory to the digital storage device prior to playing the file (page 3 paragraph 29-30). The device is a portable music player, it is therefore suggested that the music will be played.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2135

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421.


The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK

Monday, April 05, 2004

  
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